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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,918	03/11/2004	Pier Fortunato Bottan	FR920020005US1	7014
35525	7590	02/12/2008		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER KESSLER, MATTHEW E	
			ART UNIT 4121	PAPER NUMBER
			NOTIFICATION DATE 02/12/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/798,918	<b>Applicant(s)</b> BOTTAN ET AL.	
	<b>Examiner</b> MATTHEW E. KESSLER	<b>Art Unit</b> 4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/18/2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/11/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office action has been issued in response to Applicant's Amendment filed 12/18/2007. Claims 1-9 are pending in the case. Claims 1-7 have been amended (claim 7 is considered amended as being dependant upon and amended claim). Claims 8-9 are new.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Raghunandan et al. (hereinafter Raghunandan) U.S. Patent No. 6,721,785 in further view of King et al. (hereinafter King) U.S. Patent Application Publication No. 2002/0002590.

As to claim 1, Raghunandan teaches all of the limitations of the computer-implemented method, but does not teach a graphical user interface. Raghunandan teaches a computer-implemented method of using a graphical user interface of a local mail user agent for sending an electronic (e-mail) message, comprising (column 3 lines 5-13. Raghunandan describes a method for transmitting email... including providing transmission control directives by the user.):

prompting a user to provide a first input in a first input area of the graphical user interface, wherein the first input

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comprises an indication of e-mail addresses of intended message recipients (column 3 lines 5-12 teach “A method for transmitting e-mail to a plurality of recipients identified by one or more aliases in identified list or lists of recipients.” Which is controlled through “directives by the user”.);

responsive to receiving the first input, generating a list of destination e-mail addresses of intended message recipients (column 3 lines 5-25 teaches aliases are provided as the recipients and are expanded if it includes one or more aliases that are nested in an alias. Furthermore an alias is defined in column 2 lines 1-2 “an alias may correspond to a group of email addresses and may further make reference to other aliases.);

prompting the user to provide a second input in a second input area of the graphical user interface, wherein the second input comprises an indication of at least one e-mail address to be excluded from the list of destination e-mail addresses (column 3 lines 20-24 teach “applying each said parsed transmission control directive on said aliases in said identified list or lists of recipients so as to exclude or include a recipient or a group of recipients in said identified list or lists.”);

responsive to receiving the second input, modifying, by the local mail user agent, the list of destination e-mail addresses to exclude the at least one e-mail address, forming a modified list; and sending the e-mail message in accordance with the

modified list (column 3, lines 26-28 teach “The recipients are included or excluded from said identified list or lists based on the order in which the inclusion or exclusion is defined.”).

However in an analogous art, King teaches a graphical user interface (Paragraph [0019] teaches “If the sender elects to manually input the physical address of the recipient, he is prompted to input the entire physical address information into a Graphical User Interface (GUI) of an e-mail software package”).

It would be obvious for one of ordinary skill in the art to combine the e-mail method and system for exclusion of a recipient of an email of Raghunandan with King's use of a GUI in an email system because Raghunandan already teaches that recipients selected to receive and selected to be excluded are done through directives by the user. Having those directives being assigned through the use of promptings through a GUI would give a user more control through a more intuitive interface. It would have been obvious to one of ordinary skill in the art to include a GUI in an email system and method such as Raghunandan's.

The applicant has recited that claim 1 is representative of claims 4 and 6 and as such, claims 4 and 6 are rejected on the same grounds of rejection as above.

Claims 2, 3, 5, and 7 are depend from claims 1, 4 and 6. The same grounds of rejection as set forth in the previous correspondence are maintained and rejected under 35 U.S.C. 103(a) as being unpatentable over Raghunandan in further view of King. Raghunandan teaches the computer-implemented system and methods and King teaches the use of a GUI.

As to claim 8, the computer program in a working memory of a computer of claim 4 (the combination of Raghunandan and King teach all of the limitations of claim 4), wherein the first input comprises at least one pre-defined group of e-mail addresses (column 3 lines 30-31, "The said identified list or lists include **lists for sending copies and/or sending blind copies and lists for groups.**"), and wherein said generating a list of destination e-mail addresses comprises putting in the list of destination e-mail addresses each of the e-mail addresses of the pre-defined group (column 3 lines 28-29, "The recipients are included or excluded from said identified list or lists based on the order in which the inclusion or exclusion is defined." Raghunandan teaches the instance where inclusion takes precedence before exclusion and the case where exclusion takes precedence before inclusion. In the case where inclusion takes precedence, the addresses are added to the list first.).

As to claim 9, the computer program in a working memory of a computer of claim 4 (the combination of Raghunandan and King teach all of the limitations of claim 4), wherein the second input comprises at least one pre-defined group of e-mail addresses to be excluded (column 3 lines 32-39, "The said transmission control directives are by means of exclusion strings, "Deny-To", "Deny-Cc", "Deny-Bcc", "Deny-Group" and "Deny-Attachment", wherein **define recipients that are to be excluded from the identified, "To:", "Cc:", "Bcc:" and "Group:" lists** respectively while "Deny attachment" identifies recipients that are excluded from receiving

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attachments.”), and wherein said modifying, by the local mail user agent, the list of destination e-mail addresses to exclude the at least one e-mail address, forming a modified list; comprises removing from the list of destination e-mail addresses each of the email addresses of the pre-defined group of e-mail addresses to be excluded (column 3 lines 28-29, “The recipients are included or excluded from said identified list or lists based on the order in which the inclusion or exclusion is defined.”

Raghunandan teaches the instance where inclusion takes precedence before exclusion and the case where exclusion takes precedence before inclusion. In the case where inclusion takes precedence, the addresses are added to the list first, then the excluded addresses are removed. column 4, lines 21-24.).

### ***Response to Arguments***

#### **I. 35 U.S.C 102, Anticipation**

Applicant's arguments are with respect to the new claims 1-7 specifically citing the inclusion of a GUI, have been considered but are moot in view of the new ground(s) of rejection. Applicant has changed the scope of the independent claims 1, 4 and 6 and Examiner has brought in King reference to reject the amended claims. The previous rejections applied to the dependant claims 2, 3, 5, and 7 have been maintained.

Examiner has additionally rejected the newly added claims 8 and 9.

Applicant's arguments that Raghunandan does not teach "wherein the second input comprises an indication of at least one e-mail address to be excluded from the list of destination e-mail addresses" have been fully considered but they are not persuasive. The applicant has argued that Raghunandan deletes addresses from the intended recipients list and that this somehow is not equivalent to excluding those recipients from the list. Since the addresses are deleted, the examiner argues that they are in fact excluded from receiving the email since they will not receive the intended email.

II. **35 U.S.C 102, Anticipation**

Applicant's arguments in response to the 102(e) rejection based upon the Kulkarni reference have been fully considered but are moot in view of the new ground(s) of rejection. Since Applicant has amended all of the independent claims it has necessitated a new grounds of rejection as set forth by the Examiner as a 103(a) rejection above. The Examiner no longer needs to rely upon the Kulkarni reference and has instead chosen to rely upon Raghunandan in further view of King.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO



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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW E. KESSLER whose telephone number is (571)270-5005. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on (571)272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/MK/

/Taghi T. Arani/  
Supervisory Patent Examiner, Art Unit 4121  
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